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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,781	06/17/2000	GERALD SUGERMAN	VOC 429	4332
61650 7590 10/02/2008 MYERS WOLIN, LLC 100 HEADQUARTERS PLAZA North Tower, 6th Floor MORRISTOWN, NJ 07960-6834				
EXAMINER EGWIM, KELECHI CHIDI				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 10/02/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[patent@myerswolins.com](mailto:patent@myerswolins.com)

# Office Action Summary

**Application No.**

09/581,781

**Applicant(s)**

SUGERMAN, GERALD

**Examiner**

Dr. Kelechi C. Egwim

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,8,9,11-22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,10 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, species b, claims 1, 4-7, 10 and 23 in the reply filed on 07/02/2008 is acknowledged. The traversal is on the ground(s) that applicant "believes that the claimed invention is neither obvious over nor anticipated by the references cited by the examiner". This is not found persuasive for reasons cited below.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 2, 3, 8, 9, 11-22 and 24 are now withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 4-7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Riediker et al. of U.S. Patent No. 4,857,654.

Riediker et al. teach a composition of an amine compound with carbon-carbon unsaturation, namely, dialkylaminomethyldifluorobromophenyl, (see from column 5, line

68 to column 6, line 1), hydroxyl bearing, unsaturated esters, (i.e., triethylene glycol dimethacrylate of column 7, lines 58-59), and the oligomer of triethylene glycol of column 7, line 43).

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

***Claim Rejections - 35 USC § 102/103***

5. Claims 23 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Riediker et al. (USPN 4,857,654).

While Riediker et al. do not expressly teach the low toxicity properties of the claimed composition, it is reasonable that the composition of Riediker et al. would possess the claimed low toxicity properties since the composition of Riediker et al. is essentially the same as the present composition/process and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, the fact that when these known compounds are combined, as they were in Riediker et al., a toxic low environmental composition would be an inherent feature with this composition. An otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al., 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the

disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

The selection of a known material based on its suitability for its intended use supported a prima facie case for obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

Accordingly, it still would have been obvious to one having ordinary skill in the art to use the composition of Riediker et al. with an intended use recitation of using the claimed composition for latex. In addition, the courts have held, *In re Swinehart*, 169 USPQ 226, "a newly discovered property does not necessarily mean that the product is unobvious, since this property may be inherent in the prior art."

### ***Response to Arguments***

6. Applicant's arguments filed 03/07/2008 and 07/02/2008 have been fully considered but they are not persuasive.

7. Applicant argues that "Riedeker ... (only) generically refers to dialkylaminomethyldifluorobromophenyl lithium compounds" and that "the amendment after final Applicants have amended claims 1, 3-8, 10, 13, 20-21 and 24 to recite amines having a 'carbon-carbon double bond'. Amines having a carbon-carbon double bond are not described in Riediker. Riediker arguably alludes to titanocenes having aromatic groups (i.e., dialkyl-amino methyl difluoro bromophenyl groups), but such compounds do not have carbon-carbon double bonds therein."

The examiner disagrees. An aromatic benzyl group has an average of three carbon-carbon double bonds, be they aromatic or in an equilibrium state. Such bonds are carbon-carbon double bonds. The aromaticity only results from their proximity and placement to each other. By applicant's arguments, butadiene ( $C=C-C=C$ ) would be considered as also have NO carbon-carbon double bonds. This is simply not the understanding of one of ordinary skill in the art.

8. 'Regarding the argument that "triethylene glycol dimethacrylate" described in Riediker et al. is not a hydroxyl bearing unsaturated ester, it is still an ether and thus meets the requirements of the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dr. Kelechi C. Egwim/  
Primary Examiner, Art Unit 1796

KCE